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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Response to Arguments

Applicant's arguments filed 17 September 2008 have been fully considered but they are not persuasive.

The arguments presented by the Applicant are not found persuasive. Applicant argues that a sill and a sill pan by definition are structurally different and are known to be structurally different in the art. Applicant does not provide structural differences in the claims that would differentiate the claims sill pan from a sill. The sill is defined as a bottom of a window or a door, this in fact can equate also to the sill pan showing no structural difference. Depending on whether the person skilled in the art considers the door or window just to be the movable pain for example or if that includes the entire panel and frame. If the frame is included in the window and door as it appears to be then the sill pan is also a horizontal part of a window or door. The broadest definition of the word is used. Also is the Applicant wants to go by definitions, Webster's defines "flashing" as a sheet metal bent and shaped, the present invention is an extruded plastic sill pan, not a sillpan "flashing". By the broadest definitions of the sill and sill pan, there is no structural differences recited in the claims. Applicant argues that Baczuk and Wark are not properly combined. Baczuk discloses all of the claims structural limitations except for the sloped upper surface and the front flange. Wark is used to simply disclose a sloped upper surface and a front flange in a window drain which directs water towards the exterior of the building. Since Baczuk and Wark are used in fenestration openings and combine to show the claimed structural limitations of the present claims, the combination of the sill pan of Baczuk and Wark can in fact be

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integrated into the fenestration opening of a building. Window and door openings are considered analogous structures in the art, therefore there is no definite structure difference between the opening of a window or a door. The prior art of Baczuk and Wark are both disclosed as directing water away from the interior of the building and towards the exterior of the building. Baczuk discloses the weep holes and Wark discloses the sloped upper surface.

Response to Amendment

The Declaration under 37 CFR 1.132 filed 17 September 2008 is insufficient to overcome the rejection of claims 1, 10, and 18 based upon US 6,371,188 B1 to Baczuk et al. in view of US 6,385,925 B1 to Wark applied under 35 U.S.C. 103 as set forth in the last Office action because:

An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success.

The Federal Circuit has acknowledged that applicant bears the burden of establishing nexus, stating:

In the ex parte process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sales constitute commercial success. C.f. **Ex parte Remark, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990)(evidentiary routine of shifting burdens in civil proceedings inappropriate in ex parte**

prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.

In considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. In re Mageli, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973)

Applicant throughout the declaration fails to state and factual information regarding the market share of claimed invention. Applicant relies on the argument that large building suppliers sell the claimed invention, but do not provide figures on the market share of the building sales as a whole. Providing the sales figures such as the "400,000 individual units in 4 years" does not provide any type of information about the sales of sill pans as a whole, therefore it is uncertain to how many units are sold by competitors and also why there were 400,000 individual units sold. Applicant relies on an article in Energy Design Update that states "commercial success is due to the design change of the current invention. There is no evidence provided that changes in the design of the current sill were the cause of the results in the sales or the results of the changes of the market share. The article also states that Suresill has the largest

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market share than any other sill pan, but does not provide any hard evidence of this statement. There is also no statement in the declaration that has any relevance to promotions or advertisements. Advertisements play a large part in the success of a product. No statement in the declaration provides evidence that promotional appearances or advertisements did not have any affect on the "commercial success" of the claimed invention.

Establishing long-felt need requires objective evidence that an art recognized problem existed in the art for a long period of time without solution. The relevance of long-felt need and the failure of others regarding the issue of obviousness depends on several factors. First, the need must have been a persistent one that was recognized by those of ordinary skill in the art. In **re Gershon, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967)**.

Second, the long-felt need must not have been satisfied by another before the invention by applicant. **Newell Companies v. Kenney Mfg. Co., 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988)**.

Third, the invention must in fact satisfy the long-felt need. In **re Cavanagh, 436 F.2d 491, 168 USPQ 466 (CCPA 1971)**.

The key additions to the claims that the Applicant points out in the independent claims listed in the declaration are the sloped upper portion, the continuous lengthwise supports to allow extrusion, and the first and second end pieces. It is shown by the prior art of record that the three areas of emphasis were areas of

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long felt need, but the prior art also discloses that the designs of the sills/sill pans of the art of record satisfy these long felt needs. The sill pan of the present invention may have some features which are structurally different from the competitors' sill pans but that does not show evidence that the other sill pans, which are also disclosed in the articles provided do not provide for that long felt need.

Baczuk discloses forming the sill pan by extrusion with lengthwise support, Baczuk also discloses the first and second end pieces. Wark discloses a sill pan with a sloped surface to eliminate moisture from entering the opening (long felt need).

The first competitor discussed is "Jamsill" in which Applicant declares changed their design after the sill pan of the present invention was put on the market. This is simply a change in design of the competitor's product and does not relate to the patentability of the limitations of the claims.

The Wark competitor is said to have non-continuous support along with only three reported sizes. Once again this comparison does not relate to the claims at hand, since the claims fail to provide any support of "continuous support" as well as differing sizes of the sill. The amendment regarding the "continuous support" has not been entered since it would require further consideration/additional search.

It is also stated that Burk does not disclose drain channels, but the combination of Burk was to simply provide support for forming the sill pan of a metal material and not to provide the structure of the sill pan.

Applicant also states that the patents of Baczuk, Headrick, and Massey are all sills and not sill pans. There is no differentiation in the claims between a sill pan and a sill. The inventions of the above named patents all are placed in the opening of a window or a door to prevent moisture from entering the opening. Applicant provides many definitions of a sill and a sill pan, it is still not found persuasive that a sill and a sill pan are structurally different in the art. There is no recitation in the claims that would distinguish the claimed sill pan from the sill or sub-sill or Baczuk, Wark, Headrick, or Massey. The sill is defined as a bottom of a window or a door, this in fact can equate also to the sill pan showing no structural difference. Depending on whether the person skilled in the art considers the door or window just to be the movable pain for example or if that includes the entire panel and frame. If the frame is included in the window and door as it appears to be then the sill pan is also a horizontal part of a window or door. The boradest definition of the word is used. Also is the Applicant wants to go by definitions, Webster's defines "flashing" as a sheet metal bent and shaped, the present invention is an extruded plastic sill pan, not a sillpan "flashing". By the broadest definitions of the sill and sill pan, there is no structural differences recited in the claims.

Throughout the declaration, the Applicant repeatedly refers to the Suresill sill pan that has "continuous support". This is addressing an issue of the invention as a whole

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and is not directed at the claims, since the addition of the "continuous support" has not been entered due to the need for further consideration /additional search to the claims.

Regarding the submitted evidence of commercial success, specifically the letters showing compatibility. The letters simply support the idea that the sill pan is compatible with the products that the other companies provide to be used in fenestration openings. The compatibility of the sill pan of the current claims with other building materials is not persuasive to overcome the rejections of the office action. A product being compatible with another building product does not support its patentability. The support for the sill pan of the current claims on page 40 is simply a recommendation and also does not support the patentability of the sill pan.

Regarding the product recognition, the reviews and endorsements listed in the declaration do not provide insight on the claimed subject matter at hand. The statements listed do not provide any specifics to the limitations presented in the claims, they simply provide statements that the sill has been tested against others in the market.

The declaration fails to provide any factual information or hard evidence on the market share of the sill pan of the present claims. The declaration also fails to show any evidence that the sill pan does not have commercial success due to advertisements or promotion. Therefore the declaration has been insufficient to overcome the rejection of the previous mailed Office Action.

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